

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 12-33 are pending; no claims are newly added, amended, or canceled herewith.

In the outstanding Office Action, Claims 12, 13, 18-21, 23, and 29-32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Oshino et al. (U.S. Pat. No. 5,414,450, hereafter Oshino) in view of Eisaku (JP Pub. 63179770); Claims 14-16, 22, 25-27, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Oshino in view of Eisaku and further in view of Fujitsu (EP Pub. 0556071A2); and Claims 17 and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Oshino in view of Eisaku and further in view of Brooks et al. (U.S. Pat. No. 4,595,935, hereafter Brooks).

Applicant thanks Examiner Crenshaw and Supervisory Examiner Hirshfeld for the interview granted Applicant's representative on May 4, 2004. During the interview, the outstanding rejections of Claims 12-33 were discussed with regard to the references of record.

Specifically, as discussed in the interview, the outstanding rejection of Claims 12, 13, 18-21, 23, and 29-32 under 35 U.S.C. § 103(a) as unpatentable over Oshino in view of Eisaku is respectfully traversed.

As previously explained by the Applicant, it was difficult to print tickets of different widths in the past. To overcome the difficulties with past printing techniques, the Applicant developed the claimed invention, which includes a means for driving having a block applied against a second face of the ticket, opposite to the first principal face, and including a first powered rotating roller capable of causing the ticket to move, and a second idling roller, extending beyond the powered roller, which is used to drive tickets of different widths in the

direction of travel. Thus, it is no longer necessary to motorize the entirety of the block.

Simply put, only the powered roller need be motorized.¹ As recited in Claim 12, the means for guiding and the means for driving cooperate to drive tickets of different widths in the direction of travel. Claim 23 recites analogous features. As described in the specification at page 10, the angle α formed by the block 26 with the direction of travel D helps to lay the tickets against the tabs TG1 and TG2, while the idling roller 262 advantageously serves to hold the ticket without presenting any resistance. Thus, it is possible to print tickets of different widths.²

As admitted in the Office Action at page 2, Oshino fails to disclose or suggest means for guiding and means for driving that cooperate to drive tickets of different widths in the direction of travel. The Office Action attempts to remedy this admitted deficiency of Oshino by relying upon Eisaku.

However, Eisaku, like Oshino, fails to disclose or suggest cooperation between the means for guiding and a means for driving, as recited in Claim 12.

Specifically, Eisaku describes a segmented block including a powered roller, on either side of which idling rollers are placed. This arrangement of the blocks suggests that no means for guiding is provided, or that no particular cooperation is provided between the block and any possible means for guiding.

According to Eisaku, an angle between the block and the direction of travel, as recited in Claim 12, cannot be provided. More particularly, according to Eisaku, the idling roller would be placed between the powered part of the block and the tab, so a small size ticket will be driven by just a little part of the powered segment of the block, while a substantial part of the block applied against the face to print would be idling. Thus, it is evident that Eisaku does not teach a means for guiding suitable for cooperating with the segmented block.

¹ Specification, page 2, lines 5-15.

² Specification, page 10, lines 1-9.

During the interview, it was suggested that the claimed angle would be inherent in the applied combination of Oshino and Eisaku. However, as set forth in MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”³ Additionally, “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”⁴

Moreover,

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁵

In this case, no reasoning has been provided on the record as to why the claimed angle of the first powered rotating roller recited in independent Claims 12 and 23 is *necessarily inherent* in the applied combination of Oshino and Eisaku. Therefore, it is respectfully submitted that the outstanding Office Action has failed to satisfy the requirements of MPEP § 2112.

Accordingly, as the applied combination of Oshino and Eisaku is deficient for the reasons identified above, it is respectfully requested that the outstanding rejection of Claims 12, 13, 18-21, 23, and 29-32 be withdrawn.

Moreover, it is respectfully submitted that there is no basis in the teachings of either Oshino or Eisaku to support the applied combination. Certainly, the Office Action fails to cite to any specific teachings within either of Oshino or Eisaku to support the applied combination. Additionally, if the untranslated text of Eisaku is being relied upon as the source of motivation, it is respectfully submitted that a translation of Eisaku must be provided. Absent any annunciated support for the applied combination, it is respectfully

³ In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original).

⁴ In re Robertson, 169 F.3d 743, 745; 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

⁵ Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

submitted that the combination of Oshino and Eisaku is the result of hindsight reconstruction, and is improper.

With regard to the rejection of Claims 14-16, 22, 25-27, and 33 under 35 U.S.C. § 103(a) as unpatentable over Oshino in view of Eisaku and further in view of Fujitsu, that rejection is also traversed.

As explained above, the applied combination of Oshino and Eisaku fails to disclose or suggest the features of independent Claims 12 and 23, from which Claims 14-16, 22, 25-27, and 33 respectively depend. As Fujitsu is not relied upon to provide the features identified as deficient within the combination of Oshino and Eisaku, it is respectfully submitted that Claims 14-16, 22, 25-27, and 33 patentably distinguish over the applied combination of Oshino, Eisaku, and Fujitsu. It is therefore respectfully requested that this rejection be withdrawn.

Moreover, it is respectfully submitted that there is no basis in the teachings of any of Oshino, Eisaku, and Fujitsu to support the applied combination. It is respectfully submitted the applied combination of Oshino, Eisaku, and Fujitsu is improperly based upon hindsight reconstruction, especially as the Office Action fails to cite to any teachings within any of the references to support the applied combination.

With regard to Claims 16 and 27, the Office Action appears to take Official Notice at page 5 that the claimed angle would be obvious.

However, as set forth in MPEP § 2144.04, "It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Applicant respectfully requests that a reference be cited in support of this Official Notice. If no reference is cited to support the assertion, it is respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claims 17 and 28 under 35 U.S.C. § 103(a) as unpatentable over Oshino in view of Eisaku and further in view of Brooks, that rejection is also traversed.

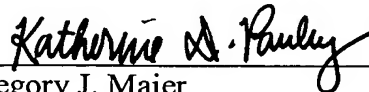
As explained above, the applied combination of Oshino and Eisaku fails to disclose or suggest the limitations in independent Claims 12 and 23, from which Claims 17 and 28 respectively depend. As Brooks is not relied upon to remedy the deficiencies noted in Oshino and Eisaku, Brooks is not substantively addressed herewith, and it is respectfully submitted that Claims 17 and 28 patentably distinguish over the applied combination of Oshino, Eisaku, and Brooks for the reasons above set forth with regard to independent Claims 12 and 23. Therefore, it is respectfully requested that this rejection be withdrawn.

It is also respectfully submitted that the applied combination of Oshino, Eisaku, and Brooks is unsupported by the teachings of any of these references. Certainly, the Office Action fails to cite to any specific teachings with any of Oshino, Eisaku, or Brooks to support this combination. It is therefore respectfully submitted that this combination of Oshino, Eisaku, and Brooks is improperly based upon hindsight reconstruction.

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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